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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,845	03/30/2004	Christophe Gouthier	116598-00114	2328
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BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			EXAMINER HINZE, LEO T	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 11/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/811,845

Applicant(s)

GOÜTHIER ET AL.

Examiner

Leo T. Hinze

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 14 August 2007 have been fully considered but they are not persuasive.
2. Applicant argues on p. 5 that the examiner did not address all of Applicant's arguments, and therefore, that this action could not properly be made final. However, it appears that the examiner did address Applicant's arguments on p. 3 of the office action mailed 06 June 2007. Therefore, this action may be properly made final.

- a. The rebuttal made by Examiner Yan on p. 3 and repeated here is as follows:

It is noted that claim 1 has been amended to recite the luminous elements form an image and the image is visible in the darkness but essentially invisible under normal lighting conditions. A careful review of the present disclosure indicates that the recited image is the shape of the luminous elements visible to the human eye in the dark. The luminous elements of the present invention do not form any other image other than their individually designed shape. This is the same structure as taught by Lange wherein the luminescent layer 20 forms an image by its designed shape visible to the human eye in the dark and covered from sight in daylight thus is essentially invisible under normal lighting conditions. Lange teaches that "the indicating portions of which are visible in the dark while the luminescent material is covered from sight in daylight" (col. 1, lines 15-19) and that "the partly translucent reflecting layer is visible when the intensity of outside light reflected by the translucent reflecting layer exceeds the intensity of light rays emitted by the luminescent body and passing through the partly translucent layer" (col. 1, 11.51-56). This means that when the light level is high enough, the light reflecting off the translucent layer 30 overpowers the light emitted from the luminescent elements 20, making the reflecting layer visible, but the luminous layer and its shape or image invisible. When the light level is low enough, the light from the luminescent elements penetrates the translucent layer, making the luminescent elements and the image they represent visible. Therefore, the luminous elements and the image they project are essentially invisible under normal lighting conditions.

- b. Examiner Hinze agrees with Examiner Yan's rebuttal, and disagrees with Applicant's argument. While the device of Lange may have an image that is visible in daylight, it appears that the image visible in daylight is formed by the translucent reflecting layer 30 (Fig. 12; "the reflecting layer will partly absorb and partly reflect the light and thus will appear when seen in daylight," col. 2, ll. 5-7), and the image formed by the luminous elements 20 is not visible in

Art Unit: 2854

daylight. Because claims 1 and 10 include the open transitional term "comprising," the inclusion in a reference of additional elements or features is not dispositive of a finding that the reference anticipates each and every element of a claim. Though Lange may have indicia and/or images which are visible during daylight, those images are not formed by luminous elements, but are instead formed by a translucent reflecting layer.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange, US 2,885,561 (hereinafter Lange).

Regarding claims 1 and 10, Lange teaches a dial, comprising: a substrate plate (45, Fig. 12); a semi-transparent layer (17, 30, Fig. 12) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or luminescent luminous elements (20, Fig. 12) lodged between said substrate plate and said semi-transparent layer; wherein said luminous elements form an image, and the image is visible in darkness but essentially invisible under normal lighting conditions (col. 1, ll. 38-45), and wherein said luminous elements are lodged in blind hollows made in said semi-transparent layer and open towards said substrate plate (see Fig. 12).

Regarding claim 4, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches the same structure that would result if said luminous elements were applied by serigraphy, tampography or manually onto said substrate plate and/or onto said semi-transparent layer. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

Regarding claim 5, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches wherein said semi-transparent layer is made of plastic ("synthetic resin," col. 5, ll. 1-2).

Regarding claim 6, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches a colored layer (30, Fig. 12) interposed between said substrate plate and said semi-transparent layer.

Regarding claim 7, Lange teaches the dial of claim 6 as discussed in the rejection of claim 6 above. Lange also teaches wherein said colored layer is a coat of varnish ("translucent brilliant varnish base," col. 3, ll. 4-5).

Regarding claim 8, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

Regarding claim 9, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2854

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is 571.272.2864. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571.272.2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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07 November 2007

  
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SUPERVISORY PATENT EXAMINER